

The opinion in support of the decision being entered today
was not written for publication and is not binding
precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES S. BRADLEY

Appeal No. 2005-0486
Application No. 09/887,836

HEARD: April 21, 2005

Before KIMLIN, WARREN, and PAWLIKOWSKI, Administrative
Patent Judges.

PAWLIKOWSKI, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134
from the examiner's final rejection of claims 1 through 5
and 11. We dismiss the appeal of claim 12.¹

Claim 1 and claim 11 are representative of the subject
matter on appeal and are set forth below:

1. A packaging laminate comprising an outer layer
impermeable to a butylated phenolic antioxidant; an

¹Claim 12 is of record, but appellant has withdrawn claim 12 from
consideration. Brief, page 4.

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adhesive layer between said outer layer and an inner layer and in contact with both said layer and said inner layer to form said packaging laminate, wherein said adhesive layer comprises an adhesive resin, a curing agent and said butylated phenolic antioxidant; and said inner layer allowing migration of said butylated phenolic antioxidant therethrough.

11. An antioxidant adhesive film comprising: a solventless cured adhesive resin selected from the group consisting of: polyether urethanes, polyester urethanes, and polyurethane; and a butylated phenolic antioxidant present in a concentration of between 1000 and 300,000 parts per million applied from 0.00005 to 0.001 dry pounds per square foot of a substrate.

The examiner relies upon the following references as evidence of unpatentability:

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|----------------------|-----------|---------------|
| Omura et al. (Omura) | 4,650,847 | Mar. 17, 1987 |
| Saad et al. (Saad) | 5,562,874 | Oct. 8, 1996 |
| Satoh et al. (Satoh) | 6,194,061 | Feb. 27, 2001 |

Claims 1 through 5 stand rejected under 35 U.S.C. § 103 as being unpatentable over Saad in view of Satoh.

Claim 11 stands rejected under 35 U.S.C. § 103 as being unpatentable over Omura in view of Satoh.

As a preliminary matter, with regard to appellant's arguments concerning entry of the amendment made to claim 11, this is a petitionable matter, and not an appealable one. Hence, the status of claim 11 is as reproduced above, and as described by the examiner on pages 2-3 of the Answer.

We have carefully reviewed appellant's Appeal Brief and Reply Brief and the Examiner's Answer. This review has

led us to conclude that the examiner's rejections are not sustainable.

OPINION

I. The 35 U.S.C. § 103 rejection of claims 1 through 5 as being obvious over Saad in view of Satoh

The examiner's position for this rejection is set forth on pages 4-6 of the Answer. Appellant's position regarding this rejection is set forth on pages 4-6 of the Brief, and on pages 3-6 of the Reply Brief.

On page 8 of the answer, the examiner responds to appellant's position regarding this rejection. Appellant argues that the teachings of Saad and Satoh are not combinable because the graft copolymerization mixture according to Satoh is incompatible with the coextrusion process detailed by Saad. In response, the examiner states that his rejection proposes to replace the adhesive of Saad with the adhesive of Satoh. Answer page 9. The examiner also states that appellant's argument depends upon the method of forming the laminate, and therefore not germane to the laminate product claimed. Answer page 9.

We cannot agree with the position taken by the examiner. Firstly, as correctly pointed out by appellants in the reply brief, the examiner's proposal to replace the adhesive layer in Saad with the adhesion layer of Satoh does not suggest the claimed invention because such a combination lacks the buytylated phenolic antioxidant. Reply Brief, pages 3-4.

Secondly, although we appreciate the examiner's discussion that process limitations are not relevant in a product claim, we believe the examiner misses the point made by appellant. Appellant's discussion of the process requirements of Saad and Satoh are relevant with respect to the issue as to whether the references are combinable. That is, if a proposal for modifying the prior art in an effort to attain the claimed invention causes the art to become inoperable or destroys its intended function, then the requisite motivation to make the modification would not have existed. See In re Fritch, 972 F.2d 1260, 1265 n.12, 23 USPQ2d 1780, 1783 n.12 (Fed. Cir. 1992). In this regard, appellants comments made on page 5 of the brief regarding the blown film extrusion process of Saad, and the incompatibility of the graft polymerization mixture of Satoh with the blown film extrusion process of Saad, is well taken.

In view of the above, we reverse the rejection of claims 1 through 5 under 35 U.S.C. § 103 as being unpatentable over Saad in view of Satoh.

II. The 35 U.S.C. § 103 rejection of claim 11 as being obvious over Omura in view of Satoh

The examiner's position for this rejection is set forth on pages 6-8 of the Answer. Appellant's position regarding this rejection is set forth on pages 6 and 7 of the Brief, and pages 6-8 of the Reply Brief.

Appellant argues that Omura does not teach that the adhesive resin is cured solventlessly; does not teach that the adhesive resin is selected from the group recited in claim 11; and does not teach that the adhesive material is applied from 0.00005 to 0.001 dry pounds per square foot of a substrate. Reply Brief, page 6.

The examiner's response regarding the issue of a "solventless cured" adhesive resin is set forth on page 12 of the Answer. The examiner states that claim 11 is a product claim, and that therefore the manner in which the adhesive is applied is not relevant. The examiner explains that the adhesive of the final product of Satoh is solventless. In paragraph 15 of the Office Action of Paper 9, the examiner states that the coating solution in Satoh is applied to a thermoplastic substrate, and dried, and it returns to the carboxylic anhydride group due to dehydration. See column 8, lines 7-9, of Satoh. The examiner states that this teaching shows that the cured/dried adhesive resin is solventless.

We believe the examiner's reasoning does not address the requirement of claim 11 that the solventless cured adhesive resin is applied from 0.00005 to 0.001 dry pounds per square foot of a substrate.² That is, in its already solventless cured state, the adhesive resin is applied from 0.00005 to 0.001 dry pounds per square foot of the

² This aspect of the claimed invention is described on page 4 of appellant's specification.

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substrate. The examiner does not point to any teaching in either Omura or Satoh that suggests this claimed recitation.


In view of the above, we therefore also reverse the 35 U.S.C. § 103 of claim 11 as being obvious over Omura in view of Satoh.

III. Conclusion

Each of the rejections is reversed.

REVERSED

Edward C. Kimlin
EDWARD C. KIMLIN
Administrative Patent Judge


CHARLES F. WARREN
Administrative Patent Judge

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) BOARD PATENT
) APPEALS
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BEVERLY A. PAWLIKOWSKI
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